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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,211	10/02/2003	Philippe Asselin	2016242-000001	9637
7590	10/13/2005		EXAMINER	
Micheline Kelly Johnson Baker, Donelson, Bearman, Caldwell & Berkowitz, PC 1800 Republic Centre 633 Chestnut Street Chattanooga, TN 37450-1800			LE, HUYEN D	
			ART UNIT	
			PAPER NUMBER	
			3751	

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/677,211	ASSELIN, PHILIPPE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Huyen Le	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) 7,10,13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,8,9,11,12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the second recess having a diameter that is at least 50 percent larger than a diameter of the first recess" should be added to the specification.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/36655.

The WO 98/36655 reference discloses a pen holder (Figs. 11, 12A and 12B) comprising a flexible body 241 having a first outwardly facing recess 245a at a first end for removably receiving a writing instrument 3 of a first radial dimension, and a second outwardly facing recess 244a at a second opposing end for removably receiving a lipstick construed as a "writing instrument" or a "marker" of a second larger radial dimension, the second recess 244a having a diameter that is at least 50 percent larger than a diameter of the first recess 245a.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/36655 in view of Chau (D 266,335).

Although the WO 98/36655 reference does not disclose the pen holder includes a clock, attention is directed to the Chau reference which showing a cap constituting a "pen holder" having a clock. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a clock on the WO 98/36655 pen holder in view of the teaching of the Chau reference for conveniently providing the time.

6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/36655 in view of Mullins (6,276,854).

Although the WO 98/36655 reference does not specifically show that the pen holder includes advertising material, attention is directed to the Mullins reference which discloses a pen holder 30 comprising an indicia such as an advertisement (col. 3, lines 46-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide an advertising material on the WO 98/36655 pen holder in view of the teaching of the Mullins reference for decorative purposes to enhance the visual effect of the device.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/36655 in view of Boulet (1.013.219).

Although the WO 98/36655 does not specifically disclose that the body of the pen holder is made of an eraser material, attention is directed to the Boulet reference which teaches a pen holder made of an "eraser" material (i.e. rubber).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made fabricate the pen holder of WO 98/36655 from an "eraser" material in view of Boulet, wherein selecting of a known material on the basis of its suitability is a matter of obvious design choice.

8. Claims 1-3, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Boulet (1.013.219) in view of WO 98/36655.

The Adams reference discloses a pen holder (Fig. 6) comprising a flexible body having a first outwardly facing recess 31 a at a first end for removably receiving a writing instrument of a first radial dimension, and a second outwardly facing recess 32 at a second opposing end for removably receiving a writing instrument of a second radial dimension.

Although the Adams reference does not specifically disclose that the second recess 32 has a diameter that is at least 50 percent larger than a diameter of the first recess 31, attention is directed to WO 98/36655 reference which discloses a pen holder

comprising a first recess and second recess having a different diameters for receiving different sizes of writing instruments, wherein the diameter of the second recess is at least 50 percent large than the diameter of the first recess.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Boulet pen holder to have a diameter of the second recess at least 50 percent greater than the diameter of the first recess in view of the teaching of the WO 98/36655 reference for holding different sizes of writing instrument.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulet (1.013.219) in view of Chau (D 266,335).

Although the Boulet reference does not disclose the pen holder includes a clock, attention is directed to the Chau reference which showing a cap constituting a "pen holder" having a clock. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a clock on the Boulet pen holder in view of the teaching of the Chau reference for conveniently providing the time.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulet (1.013.219) in view of Mullins (6,276,854).

Although the Boulet 98/36655 reference does not specifically show that the pen holder includes advertising material, attention is directed to the Mullins reference which discloses a pen holder 30 comprising an indicia such as an advertisement (col. 3, lines 46-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide an advertising material on the Boulet pen holder in view of the teaching of the Mullins reference for decorative purposes to enhance the visual effect of the device.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hoiseth, Lipkowski and Zazzara show pen holding devices. Thomas teaches a holding device capable of holding pens.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 571-272-4890. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 11, 2005



Huyen Le  
Examiner  
Art Unit 3751